

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALDEMAR BAKLARZ

Appeal No. 1997-0031
Application 07/987,669¹

ON BRIEF

Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Waldemar Baklarz appeals from the final rejection (Paper No. 8) of claims 17 through 21, 24 and 25, all of the claims

¹ Application for patent filed December 9, 1992. According to appellant, the application is a continuation-in-part of Application 07/844,508, filed March 2, 1992, now abandoned.

pending in the application.² We reverse.

The invention relates to "a process for using a set of transparent and opaque ceramic colors or mineral pigments to obtain a permanent representation of full-tone, full-color photographs on a base" (specification, page 1). A copy of the claims on appeal appears in the appendix to the appellant's reply brief (Paper No. 25).

Claims 17 through 21, 24 and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claim 24 also stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

Reference is made to the appellant's main brief (Paper No. 20) and to the examiner's main answer (Paper No. 21) for

² Independent claim 17 has been amended subsequent to final rejection. As noted by the examiner on page 3 in the supplemental answer (Paper No. 26), the amendment to claim 17 renders dependent claim 19 redundant.

the respective positions of the appellant and the examiner with regard to the merits of these rejections.³

Before discussing the merits of the rejections, we note that the appellant appears to have raised as an issue on appeal the 35 U.S.C. § 132 objection which was set forth in the final rejection (see page 4 in the main brief). This objection, however, is not directly connected with the merits of issues involving a rejection of claims and therefore is reviewable by petition to the Commissioner rather than by appeal to this Board. See In re Hengehold, 440 F.2d 1395, 1403-1404, 169 USPQ 473, 479 (CCPA 1971). Accordingly, we shall not review or further discuss the 35 U.S.C. § 132 objection.

Turning now to the first of the examiner's rejections,

³ Upon reconsideration (see pages 2 and 3 in both the main and supplemental answers), the examiner has withdrawn (1) certain portions of the 35 U.S.C. § 112, second paragraph, rejection set forth in the final rejection, (2) the 35 U.S.C. § 112, first paragraph, enablement rejection set forth in the final rejection and restated on pages 5 and 6 in the main answer, and (3) the 35 U.S.C. § 112, first paragraph, enablement rejection entered for the first time on pages 7 and 8 in the main answer.

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the second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of

the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Id.

According to the examiner, independent claim 17, and claims 18 through 21, 24 and 25 which depend therefrom, are indefinite for a variety of reasons.

To begin with, the examiner considers the phrase "a drying silk-screen printing oil preparation" in claim 17 (clause a) to be indefinite because it is not clear, and the specification does not define, what this preparation is (see page 4 in the main answer). Page 27 of the appellant's

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specification, however, denotes "silk-screen Printing Oil No. 80661 from DEGUSSA" as an example of such a drying silk-screen printing oil preparation. Viewed in light of this disclosure, the claim limitation in question has a reasonably precise meaning.

The examiner also regards the language in claim 17 (clause c) referring to the sets of "transparent and opaque" ceramic colors and mineral pigments to be indefinite because it is not clear how a color or pigment can be both transparent and opaque at the same time (see page 4 in the main answer). The language

in question, however, reasonably construed, does not require a color or pigment which is both transparent and opaque. It merely defines sets which include both transparent and opaque colors or pigments.

Finally, the examiner views claims 24 and 25 as being indefinite due to the language therein relating to the "sets" (claim 24) or "set" (claim 25) of four different colors or pigments (see pages 4 and 5 in the main answer). There is no

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question that claims 24 and 25 are rather unartfully drafted. Nonetheless, when read in context and in light of the underlying disclosure, they merely identify with sufficient clarity the four different colors (or pigments) mentioned in parent claim 17.

Thus, the examiner's concern that claims 17 through 21, 24 and 25, are indefinite is not well founded. Therefore, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.

As for the 35 U.S.C. § 112, first paragraph, written description rejection, the test for determining compliance with the written description requirement is whether the disclosure of

the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089,

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1096 (Fed. Cir. 1983).

In the present case, the examiner deems the "sets" language in claim 24 as being without a basis in the original disclosure (see pages 6 and 7 in the main answer). While this language does indeed lack literal support in the original disclosure, as pointed out above it merely identifies the four different colors (or pigments) mentioned in parent claim 17. The disclosure of the application as originally filed, particularly specification pages 13, 14 and 27 through 30 and original claim 24, would reasonably convey to the artisan that the appellant had possession at that time of such claimed subject matter.

Therefore, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, written description rejection of claim 24.

The decision of the examiner is reversed.

REVERSED

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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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Graham & James
885 Third Avenue
24th Floor
New York, NY 10022-4834

jpm/ki